

JUN 25 2007

REMARKS

The instant Amendment responds fully to the Office Action mailed on March 26, 2007, in this application. In the Amendment, claims 3-7 and 16 have been amended, and claims 8, 9, 12, 13, 17, 19 and 20 have been cancelled without prejudice or disclaimer of subject matter. Claims 1-7, 10, 11, 14, 16 and 18 are pending hereinafter, where claim 1 is the sole independent claim. Reconsideration of the rejection of claims 6, 7, 11, 14, 16 and 18 under 35 USC §112, second paragraph, and the rejection of claims 1-7, 10, 11, 14, 16 and 18 under 35 USC §103(a) in view of the amendments to claims 3-7 and 16 is respectfully requested.

Response To Rejections Under 35 USC §112

Claims 6-20 were rejected under 35 USC § 112, second paragraph, for asserted indefiniteness. The Examiner's argument to support the rejection includes first defining several variables (S, L, 2, 3). After defining the variables, the Examiner then asserts that claims 6-20 are illogical in view of the Claim 1 requirements. In particular, the Examiner asserts with respect to claims 6 and 7 that the limitations of claim 1 and claim 6 render claims 6-20 inoperable under the Second Paragraph of Section 112.

The Examiner defines the variables to include the small diameter and large diameter of the soft section of claim 1 as "S" and "L" (where  $L > S$ ), respectively, the diameter of the soft section of the second endoscope as " $D_2$ ," and the diameter of the soft section of the third endoscope as " $D_3$ " (we have added the "D's" to "2" and "3," and "subscripted" the "2" and "3" for understandability).

The Examiner then asserts with respect to claims 6 and 7, that where  $S = D_3$  (Claim 1 requires  $S = D_3$ ), the invention must be non-functional, or inoperable because where  $D_2=L$ ,  $D_3$  MUST =L, and that the premise of claims 6/1 MUST be violated because such condition would force  $S=L$ . The Examiner states that “[c]laims 6 and 7 require  $S=D_3$ . This is not possible in the situation where:  $D_2=L$  because the  $D_3=1$  but  $S$  cannot equal  $L$ .”

In response, and as mentioned above, applicant has amended claims 3-7 and 16, to respond fully to the substance of the Examiner's rejections under Section 112, and has cancelled claims 8, 9, 12, 13, 17 and 19-20.

For example, claim 3 (1/3), from which claims 10, 11 and 18 depend, is amended hereby to remove the phrase “equal to,” such that the claim now reads: “wherein the outer diameter of at least the large-diameter portion of the first endoscope is substantially equal to the outer diameter of the soft section of the second endoscope and is larger than the outer diameter of the soft section of the third endoscope.” Claim 4 (1/4), as amended now reads: “wherein the outer diameter of at least the large-diameter portion of the first endoscope is -smaller than the outer diameter of the soft section of the second endoscope and is substantially equal to the outer diameter of the soft section of the third endoscope.

Claim 5, from which claims 14 and 15 depend, is amended to read: wherein the outer diameter of at least the large-diameter portion of the first endoscope is smaller than the outer diameter of the soft section of the second endoscope and is larger than the outer diameter of the soft section of the third endoscope. Claim 6 as amended now reads: wherein the outer diameter of the small-diameter portion of the first endoscope is substantially equal to the outer diameter of the soft section of the third endoscope, and the outer diameter of the

large-diameter portion of the first endoscope is not equal to the outer diameter of the soft section of the second endoscope.

Claim 7, as amended, now reads: wherein the outer diameter of the small-diameter portion of the first endoscope is equal to or larger than the outer diameter of the soft section of the third endoscope, and the outer diameter of the large-diameter portion of the first endoscope is not equal to the outer diameter of the soft section of the second endoscope. And claim 16 as amended now reads: wherein the outer diameter of the small-diameter portion of the first endoscope is substantially equal to the outer diameter of the soft section of the third endoscope, and the outer diameter of the large-diameter portion of the first endoscope is substantially equal to the outer diameter of the soft section of the second endoscope, and the outer diameter of the large-diameter portion of the first endoscope is not equal to the outer diameter of the soft section of the second endoscope.

Applicant respectfully asserts that amendments to claims 3-7 and 16, provide that claims 6 and 7, as amended, do not violate the diameter size requirements set forth in claim 1, from which they depend. Pending claims 10, 11, 14, 15, 16 (amended) and 18, do not violate the diameter size requirements of claim 3 (1/3), from which claims 10, 11 and 18 depend, claims 14, 15, from which claim 5 (1/5) depend, and claim 1, from which claim 18 depends. Claims 8, 9, 12, 13, 17, 19 and 20 are cancelled. Applicant, therefore, respectfully asserts that pending claims 6, 7, 10, 11, 14, 15, 16 and 18, as amended, fully comply with USC Section 112, second paragraph, and requests withdrawal of the rejections thereunder.

Response To Rejections Under 35 USC §103(a)

Claims 1-20 were rejected under 35 USC §103(a) as unpatentable over US Patent No. 5,885,208, to Moriyama, in view of US Patent N. 4,690,175 to Ouchi, et al. (Ouchi).

Claim 1

With respect to claim 1, the Examiner asserts that Moriyama teaches the use of multiple sized endoscopes (7, 207, 307, 407), that each share a video processor (4) and light source (3), as found in Moriyama at col. 19, lines 13-16. The Examiner further asserts that Moriyama teaches applicants' soft portion as claimed (13, 213, 313, 413) that each have different diameters (col. 19, lines 25-29, 40-41 and 45-47), that Ouchi teaches the use of flexible tubes having a small diameter (A) and a large diameter (B) to vary the flexibility (Figs. 1 and 5, col. 7, lines 13-35), and that it would have been obvious to provide the Ouchi flexible tubing with Moriyama to provide an endoscope system of Moriyama to provide an endoscope with varying flexibility as taught by Ouchi.

Applicants respectfully disagree. The proposed combination is also believed to be improper because the stated reason for making the proposed combination is insufficient under the law of Section 103(a). That is, while the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an endoscope using the flexible tubing of Ouchi with the endoscope system of Moriyama in order to provide an endoscope with "varying flexibility," as taught by Ouchi's Abstract, applicants respectfully asserts that the Examiner's stated reason is improper under the law of Section 103(a).

Under the recently decided US Supreme Court case, KSR Int'l. Co. v. Teleflex, Inc., Slip Op. No. 04-1350 (US April 30, 2007), the Examiner's stated reasoning as to why the skilled artisan would make such a proposed combination fails to establish a *prima facie* case of obviousness. Moreover, applicant's claim language is not so broad as to merely set forth an endoscope with varying flexibility, so the Examiner's reasoning fails to address the scope and content of the prior art, rendering the asserted combination improper under Section 103(a) and KSR. Even *assuming arguendo*, however, that the Examiner's stated reason why the skilled artisan would think to combine Ouchi with Moriyama, the proposed combination would still not render obvious rejected independent claim 1.

Applicant's independent claim 1, the sole pending independent claim, teaches an endoscope system with a first endoscope having a soft section that comprises a small-diameter portion formed on the distal side of the soft section and a large-diameter portion which is formed on the operator side thereof opposite to the small-diameter portion and whose outer diameter is larger than the outer diameter of the small-diameter portion, a second endoscope that can share the same light source unit or video processor with the first endoscope and that has a soft section whose outer diameter is substantially the same over the whole length thereof, and a third endoscope that can share the same light source unit or video processor with the first endoscope, and that has a soft section whose outer diameter is substantially the same over the whole length thereof and is substantially equal to or smaller than the outer diameter of the soft section of the second endoscope.

Moriyama (which is commonly owned), as distinguished, discloses an endoscope system shown in the patents Fig. 10 and 11. Moriyama's Fig. 10 and 11 are described in detail at col. 19, line 6, through col. 20, line 65. While the Examiner asserts that

Moriyama teaches applicants' soft portions (13, 213, 313, 413) that each have different diameters (col. 19, lines 25-29, 40-41 and 45-47), and that Moriyama further teaches the use of varying softness for the endoscopes (at Figs. 23, 24, 26, 27 and 29-33), applicant disagrees.

In particular, applicant has studied the Moriyama text cited by the Examiner to support the Section 103(a) rejection of claim 1. Applicant finds that the cited Moriyama text merely asserts that endoscope 402 has a larger diameter than that of endoscope 302, but does not mention the size of the diameters of 313, 413. Put another way, there is no limitation found in Moriyama that reflects the limitations of applicants' claim 1. The claim 1 limitations include that the claimed system has three endoscopes, where each endoscope has a soft section, and that the diameters of the soft section of the first endoscope, are S and L, and  $S \leq L$ , that the diameters of the second and third endoscope soft sections do not change, and that the diameter of the third endoscope must always be less than or equal to the diameter of the second endoscope ( $D_3 \leq D_2$ ).

Ouchi discloses a flexible tube for an endoscope. While Ouchi teaches the use of flexible tubes having a small diameter (A) and a large diameter (B) to vary the flexibility (Figs. 1 and 5, col. 7, lines 13-35), the reference does not include or even suggest the limitations of claim 1. For that matter, only endoscope 1 of Ouchi includes a large diameter and a small diameter. The relationship between the small-diameter portion and the large-diameter portion of Ouchi's endoscope is not defined anywhere in Ouchi, so is unclear, or indefinite.

Hence, because the relationship between the small-diameter portion and large diameter portion of Ouchi, and size of the endoscope(s) disclosed by Moriyama is unclear, applicant believes that rejected independent claim 1 is patentable under 35 USC §103(a) by

Moriyama in view of Ouchi, and respectfully request withdrawal of the claim 1 rejection thereunder.

Claims 2-5

With respect to the rejection of claims 2-5 under Section 103(a), the Examiner asserts that Ouchi teaches using different tubes to vary flexibility (Fig. 2), and that it would have been obvious to use different designs for the endoscope tubes to realize flexibility in Moriyama's endoscope system (Abstract, Figs. 1, 2 and 5).

In response, applicant respectfully asserts that claims 2-5 are patentable for at least the reasons set forth (above) for the patentability of independent claim 1 under Section 103(a) in view of the proposed Moriyama/Ouchi combination, and request withdrawal of the rejection of claims 2-5, thereunder.

Claims 6-20

With respect to the rejection of claims 6-20 under Section 103(a), the Examiner asserts that Moriyama teaches multiple endoscopes with varying diameters, and a variety of flexibility, the Ouchi teaches using a flexible tubing to provide varying flexibility (Figs. 1, 2 and 5), and that it would have been obvious to combine Moriyama and Ouchi.

In response, applicant respectfully asserts that claims 6, 7, 10, 11, 14, 15, 16 and 18, which depend from independent claim 1, and/or dependent claim 3, respectively, are patentable for at least the reasons set forth (above) for the patentability of independent claim 1, and dependent claim 3, under Section 103(a) in view of the proposed Moriyama/Ouchi

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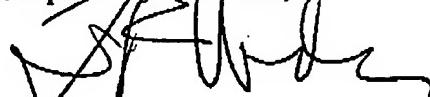
combination, and request withdrawal of the rejection of claims 6, 7, 10, 11, 14, 15, 16 and 18, thereunder.

Conclusion

In concluding, applicant respectfully submits that, for the reasons discussed above, that each of pending claims 1-7, 10, 11, 14, 15, 16 and 18, the currently pending claims, patentably distinguish over the prior art and are allowable, and request that the Examiner withdraw the rejections, and allow the claims.

If the Examiner believes that a telephone conference with applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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